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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/209,454

Filing Date: December 11, 1998

Appellant(s): TANAKA ET AL.

Jeffrey A. Wyand
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/14/2005 appealing from the Office action mailed 10/21/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,958,280	PAULY	09-1990
5,983,201	FAY	11-1999

5,659,741 EBERHARDT 08-1997

Steltzer, Thomas M., Cashing in on quicker delivery times. (Johnson and Johnson's Vistakon Inc.), Chilton's Distribution, June 1991 Dialogue file 148:05188611

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 17, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of Eberhardt (U.S. 5,659,741).

As per claim 17, Pauly et al teach:

A method of selling prescription contact lenses said method comprise:

transferring contact lens customer identification, address, and diagnostic data pertaining to a respective contact lens customer from a plurality of second group information processing apparatus located at respective facilities of contact lens prescribers, the plurality of second group information processing apparatus being connected through a communication network to a first group information processing apparatus located at a facility of a contact lens seller, to the first group information processing apparatus through the communication network (see column 2, line 35 – column 3, line 5; column 3, line 36 – column 4, line 38; column 5, lines 4-18; column 6, lines 11-33);

assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostic data transferred to the contact lens seller (see column 6, lines 39-45);

Pauly fails to teach:

providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the contact lens customer address data, from the contact lens seller to the contact lens customer, through the communication network; delivering a contact lens from the selling agent to the contact lens customer; transferring delivery data from the selling agent to the contact lens seller through the communication network. However, Fay teaches a system that "if a customer desires to purchase an eyeglasses frame, an order form is presented to the customer's personal computer for entry of relevant purchase information. The customer can select delivery of the frames to the customer's location or direct that the frames to be obtained via a selected optical retail store. In the latter situation, the RES includes an optical retail database 40 for storage of optical retail location information which can be presented to the customer". Also, Fay teaches "the customer, when placing an order for prescription eyeglasses, provides both the frame the customer would like and also a lens prescription" (see column 8, lines 35-40). Also, although Fay teaches a system that relates to the selection of eyeglass frames and not to contact lenses, it can be used to view, select, and purchase other head related products (see column 9, lines 1-14). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if Pauly uses the customer's address to deliver contact lenses to said customer instead of the prescriber (see Pauly column 7, lines 42-48), then Pauly would also look for a seller's agent (i.e. optical retail location; see Fay column 6, lines 35-54; "other location convenient for the

customer" see Fay column 7, lines 59-65) closest to the customer's address to deliver said contact lenses to said seller's agent which would finally deliver said contact lenses to said customer, as taught by Fay. Therefore, if the selling agent is an optical retail store (see Fay column 6, lines 35-40), or another prescriber location (see Fay column 5, lines 25-40) the customer would go to that said convenient location to order and pick up said contact lenses. Therefore, expediting the obtaining of the said contact lenses in comparison of waiting to receive said contact lenses by mail. Also, Pauly teaches a program that process credits issued by sales representatives (see column 8, lines 60-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sales representative or agents (see Pauly column 8, lines 60-62; see Fay "optical retail location" column 8, lines 60-62, "other diagnostic location" column 5, lines 25-40) would indicate to contact lens sellers (see Pauly figure 1, item 101; see Fay figure 1, item 20), the status of the delivery data of said lenses for purpose of processing credits (see Pauly column 8, lines 60-62) and fees (see Fay column 6, lines 47-50). This way the contact lens sellers would know the delivery status of said contact lenses and would adjust the wear schedule and shipment schedule for said customer (see Pauly column 7, lines 9-21), particularly when Pauly wants to insure an ongoing and ready supply of lenses in accordance with the prescribed wear schedule (see Pauly column 12, lines 30-50).

Pauly teaches determining an exchange time for exchanging the contact lens, based upon date of issuance of the contact lens and characteristics of the contact lens, by the first group information processing apparatus of the contact lens seller (see Pauly

column 6, lines 54-63; column 7, lines 9-21, column 9, lines 54-67) but fails to teach using data recorded on the portable recording medium of the corresponding contact lens customer to whom a contact lens has been issued by the contact lens seller through the selling agent and writing, through both the first group information processing apparatus and the plurality of second group information processing apparatus, on respective portable recording media for each contact lens customer, data, including the corresponding registration number, and issuing the corresponding portable recording medium to the respective customer, so the contact lens customer can select any contact lens prescriber, and change between any contact lens prescriber, having access to one of the second group information processing apparatus and the communication network without changing the contact lens seller. Nevertheless, Eberhardt teaches a portable recording medium that stores patient's medical data, such as prescription information, expiration date, date of purchase, refills and prescription's date of completion (see column 6, lines 28-31; column 3, lines 39-67; column 4, lines 50-53; column 14, lines 13-36). Fay teaches "A customer diagnostic location 10 may be unmanned booth including all the hardware and software needed to accomplish the two tasks of determining the customer information and communicating with the remote electronic store. A customer diagnostic location 10 may be located in any appropriate location, including on the premises of an optician or an optometrist. In the preferred embodiment, the remote electronic store 20 provides through a customer diagnostic location interface 24 an available password for the customer diagnostic location to issue to a customer, although may other schemes are possible for ensuring that different

customer diagnostic locations do not issue the same password" (see Fay column 5, lines 25-55). Also Fay teaches "In another aspect of the present invention, a customer will leave a customer diagnostic location 10 not only with a password, but also with a disk including a password and a copy of a digital image of the customer's head and face, along with software that automates linking to the remote electronic store 20 from a personal computer at a location convenient for the customer" (see column 7, lines 58-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly would use a portable recording medium, as taught by Eberhardt and Fay (i.e. disk; see Fay column 7, lines 59-65; see Eberhardt column 6, lines 27-32) to store customer's medical record or diagnostic data, that said data would be used to order contact lenses in different diagnostic locations or prescriber premises (i.e. "premises of an optician, ophthalmologist or optometrist" see Fay column 5, lines 25-31), but still ordering said contact lenses from the same remote seller (see Pauly figure 1, item 38; see Fay figure 1, item 20). Therefore, this way a contact lens customer would present the portable recording medium to any contact lens prescriber (see Fay figure 1, item 10) or to a seller's representative (see Fay figure 1, item 42) that would read said customer's diagnostic data from said portable recording medium for the purpose of ordering contact lens products, even when said customer is very ill, unconscious, unable to speak, ignorant about his or her medical history or lack of mental or education capacity to retain or understand information given to them (see Eberhardt column 1, lines 39-55).

Pauly teaches and notifying a contact lens customer to whom a contact lens was issued of the exchange time (see column 1, lines 46-65; column 3, lines 5-25; column 6, lines 11-65).

As per claim 19, Pauly does not expressly teach:

The method of Claim 17, including offering new contact lenses to the contact lens customer in exchange for old contact lenses at irregular times, upon any of loss of transparency of the contact lenses, breakage of the contact lenses, and scratching or soiling of the contact lenses, and a monthly payment by the contact lens customer.

Pauly teaches in column 3, lines 20-25 that patients are billed on a desired periodic basis for the replacement of contact lenses based upon said contact lenses wear schedule. Also, Pauly teaches in column 12, lines 59-67 "Referring next to figure 3, there is shown program DLR902, a sequence of processing used to maintain and to achieve alteration of the patient information. For example, in the ordering process set forth in Figs 2A and 2B, respective right and left lens parameters as well as lens wearing and disposables cycles are provided. Conventionally, patients' needs may change, and mechanism is provided for substantially automatic and ready alteration of the standing prescription and appropriate adjustment of all requisite files". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that even though a patient would have a set up wear schedule where it would receive new contact lenses according to a set up time, as taught by Pauly (see column 7, lines 10-21), if, for whatever reason, the patient needs changes, such as breaks a contact lens or scratches it, even though he/she is not

scheduled to receive new contact lenses, he/she may choose to alter the ordering process and get the contact lenses out of schedule because out of convenience, his or her preference and/or the better quality of vision provided by the contacts.

As per claim 21, Pauly teaches:

The method of claim 19, including contracting for a one year term with the respective contact lens customer for supplying long-term-use contact lenses in exchange for the old contact lenses and the monthly payment (see column 7, lines 9-48; column 3, lines 20-25).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of Eberhardt (U.S. 5,659,741) and Dawson, Jr. et al (U.S. 5,623,242).

As per claim 18, Pauly teaches:

The method of Claim 17, but does not expressly teach including delivering notification of an approaching deadline to replace the contact lens from the contact lens seller to the contact lens customer through the communication network. Dawson teaches a system where patient prescription information is entered and stored in a database and a remainder signal is generated and transmitted to a patient in response to the stored information (see column 2, lines 10-25). Pauly teaches "DLP011 this is the account enrollment file and identifies accounts who have purchased a start-up kit and contains summary information regarding sales (including special handling charges and taxes) and patient enrollment (including patient wear cycle and shipping schedule). This file is initially loaded and updated by the order entry program. Patient information is

changed by the program allowing changes to the patient master. Sales information is changed by programs producing the report to bill-to's about ship-to activity. This file is used for monthly patient enrollment analysis and for a weekly bill-to sales report. It is also used by the order entry program to determine eligibility to place patient or stock orders" (see column 10, line 59- column 11, line 4). Also, Pauly teaches "standing order process may be integrated with inventory surplus and backorder conditions, so long as, in all events, patients receive prescription refills adequately in advance of depletion of their standing prescription" (see column 13, lines 40-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly would store a patient's prescription wear schedule in a database and would send a remainder message to the patient, as taught by Dawson that would indicate that the time to replace the contact lenses is due, so patients are insured an ongoing and ready supply of lenses in accordance with the prescribed wear schedule (see Pauly column 12, lines 30-42).

Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of the article Cashing in on quicker delivery times and Eberhardt (U.S. 5,659,741).

As per claim 20, Pauly fails to teach the method of Claim 17, including periodically offering for sale contact lens care articles by the contact lens seller to the customer through the communication network. However, the article Cashing in on quicker delivery times teaches about a system where the contact lens provider offers to its customers 99.99 percent on-time delivery of its product when using the contact lens

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provider ordering network and offers customers the option of ordering product direct from local distributors (see paragraphs 3-7). Pauly teaches the billing of patients on a desired periodic basis to receive contact lenses (see column 3, lines 20-25). And Fay teaches "Although the system and method of the present invention are shown with respect to selection of eyeglass frames, the system and method can be used to view, select and purchase other head related products, such as jewelry, cosmetics and hair products" (see Fay column 9, lines 5-10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly's customers would use the contact lens provider network system, as taught by the article to order head related products (see Fay column 9, lines 5-10) and would be billed on a desired periodic basis for the receiving of said products based upon a wear schedule, as taught by Pauly. This feature would give customers a reliable venue to obtain the products related to their contact lens care and would insured an ongoing and ready supply of the necessary products to use said contact lenses based upon a prescribed wear schedule.

As per claim 22, Pauly fails to teach:

The method of claim 20, including periodically offering for sale the contact lens care articles based upon a consumption period of the contact lens care articles and date of most recent sale of the contact lens care articles to the respective contact lens customer transmitted form the first group information processing apparatus. Pauly teaches a system that changes the wear schedule and shipment of the contact lenses deliver to customers (see column 7, lines 9-11) and also teaches periodically offering for

sale contact lenses to respective contact lens customers based upon consumption period (see Pauly column 3, lines 20-25; column 12, lines 30-50). And as explained in claim 20, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly's customers would use the contact lens provider network system to order contact lens products and change the wear and shipment schedule of said products, as taught by Pauly. This feature would give customers a reliable venue to obtain products related to their contact lens care and would insure an ongoing and ready supply of the necessary products to use said contact lenses based upon a prescribed wear schedule.

(10) Response to Argument

The Appellant argues that because Pauly teaches in column 2, lines 17-22 that his system "allows attending eye care professionals to maintain a close doctor-patient relationship and provide initial and ongoing prescription fulfillment with minimal intrusion into that relationship", then the entire thrust of Pauly is to supply contact lenses through a prescriber, essentially chaining a contact lens user to that prescriber rather than encouraging direct interaction between the contact lens user and a contact lens seller or his selling agent. The Appellant further argues that the loyalty established by the method described in claim 17 is between the contact lens user and the contact lens seller or selling agent and this feature was not recognized in the Final rejection.

The Examiner answers that even though Pauly teaches of allowing attending eye care professionals to maintain a close doctor-patient relationship. Pauly does not mention that medical records or prescription data of said patient can only be accessed

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by said doctor or that said doctor prohibits other prescribers to have access to said medical records or that said patients are prohibited from obtaining their medical records and visit other doctors. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly would use a portable recording medium, as taught by Eberhardt and Fay (see Fay column 6, lines 35-55, to store diagnostic data or customer's medical records, such as prescription data to use said data to order contact lenses in different diagnostic locations or prescriber premises (i.e. "premises of an optician, ophthalmologist or optometrist"¹) or from a seller's representative (i.e., optical retail location"), but still ordering said contact lenses from the same online remote seller² This way a contact lens customer would present the portable recording medium to any contact lens prescriber³ or to a seller's representative⁴ that would read said customer's diagnostic data from said portable recording medium for the purpose of ordering contact lens products, even when said customer is very ill, unconscious, unable to speak, ignorant about his or her medical history or lack of mental or education capacity to retain or understand information given to them⁵

The Appellant argues that Pauly does not teach the delivery of contact lenses from a selling agent to a contact lens customer because in Pauly the relationship is

¹ see Fay column 5, lines 25-31

² see Pauly figure 1, item 38; see Fay figure 1, item 20.

³ see Fay figure 1, item 10.

⁴ see Fay figure 1, item 42

⁵ see Eberhardt column 1, lines 39-55.

between the prescriber and the user. The Examiner answers that Fay teaches about a system that "if a customer desires to purchase an eyeglasses frame, an order form is presented to the customer's personal computer for entry of relevant purchase information. The customer can select delivery of the frames to the customer's location or direct that the frames to be obtained via a selected optical retail store. In the latter situation, the RES includes an optical retail database 40 for storage of optical retail location information which can be presented to the customer". In addition, Fay teaches that "the customer, when placing an order for prescription eyeglasses, provides both the frame the customer would like and also a lens prescription"⁶ And, although Fay teaches a system that relates to the selection of eyeglass frames and not to contact lenses, the system can be used to view, select, and purchase other head related products⁷. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if Pauly uses the customer's address to deliver contact lenses to said customer instead of the prescriber⁸, then Pauly would also look for a seller's agent (i.e. optical retail location⁹; "other location convenient for the customer"¹⁰) closest to the customer's address to deliver said contact lenses to said seller's agent which would finally deliver said contact lenses to said customer, as taught by Fay. Therefore, if the selling agent is an optical retail store¹¹, or another prescriber

⁶ (see column 8, lines 35-40).

⁷ (see column 9, lines 1-14)

⁸ (see Pauly column 7, lines 42-48)

⁹ see Fay column 6, lines 35-54

¹⁰ see Fay column 7, lines 59-65

¹¹ (see Fay column 6, lines 35-40)

location¹² the customer would go to that said convenient location to order and pick up said contact lenses. This feature would expedite the process of obtaining the said contact lenses against receiving said contact lenses by mail. Also, Pauly teaches a program that process credits issued by sales representatives¹³. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that sales representative or agents, such as the one taught by Pauly (i.e. optical retail location¹⁴; "other diagnostic location"¹⁵) would indicate to contact lens sellers, the status of the delivery data of said contact lenses for purpose of processing credits¹⁶ and fees¹⁷. This way the contact lens sellers would know the delivery status of said contact lenses and would adjust the wear schedule and shipment schedule for said customers,¹⁸ specially when Pauly wants to insure an ongoing and ready supply of lenses in accordance with the prescribed wear schedule¹⁹.

The Appellant argues that Fay concerns dispensing of eyeglass frames through a virtual optician and there is no medical implications in the selling of eyeglass frames. The Examiner answers that Fay teaches²⁰ "the customer when placing an order for prescription eyeglasses, provides both the frame the customer would like and also a lens prescription". Therefore, in Fay a customer needs a prescription to place an order

¹² (see Fay column 5, lines 25-40)

¹³ (see column 8, lines 60-62).

¹⁴ see column 8, lines 60-62

¹⁵ see Fay column 5, lines 25-40

¹⁶ (see Pauly column 8, lines 60-62)

¹⁷ (see Fay column 6, lines 47-50).

¹⁸ (see Pauly column 7, lines 9-21),

¹⁹ (see Pauly column 12, lines 30-50).

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for prescription glasses, where said prescription can only be obtained from a medical doctor or license prescriber. Therefore, the Fay system ordering system has a medical implication contrary to Appellant's argument.

The Appellant argues that a person obtaining contact lenses would have no reason to employ the system described by Fay to determine how his facial appearance might change when using contact lenses. The Examiner answers that Fay was used by the Examiner to teach a portable recording medium²¹ and to teach that a customer can select delivery of the product to a selected retail location (i.e. seller's agent or representative). Since, in the Pauly and Fay systems, a customer would need a prescription to order eyewear and in both systems said customers access an online store to order said products,²² Pauly and Fay systems are analogous arts.

The Appellant argues that claim 19 teaches a program of offering replacement contact lenses to a customer at regular intervals when previously supplied contact lenses are no longer usable, provided the customer makes a monthly payment for the supplying of contact lenses on a regular basis and that the Office action rejection is erroneous because there is no factual basis for the rejection.

The Examiner answers that claim 19 recites "The method of Claim 17, including offering new contact lenses to the contact lens customer in exchange for old contact lenses at irregular times, upon any of loss of transparency of the contact lenses, breakage of the contact lenses, and scratching or soiling of the contact lenses, and a

²⁰ see column 8, lines 36-40

²¹ see Fay column 7, lines 59-65

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monthly payment by the contact lens customer". The Claim does not read at "regular intervals" as the Appellant appears to argue, but reads at "irregular intervals". Therefore, the Appellant is arguing about features that are not in the claim.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Daniel Lastra

DL

Conferees:

Eric Stamber *ESt*
Raquel Alvarez *Raqel*

Raquel M
RAQUEL ALVAREZ
PRIMARY EXAMINER

²² (see Pauly figure 1, item 101; Fay figure 1, item 20),